



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,086	10/30/2003	Ronald H.P. Brus	2578-6158US	9184
24247	7590	12/15/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			LUCAS, ZACHARIAH	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Notice of Non-Responsive Amendment

Art Unit: 1648

DETAILED ACTION

1. A Requirement for Restriction was mailed in the application on September 22, 2004. In an attempt to avoid making an election, the Applicant has amended certain claims such that they read only on the generic invention, and no longer specifically identify the various subgroups that fall within the generic linking claim. However, contrary to the Applicant's assertion, this is not sufficient to avoid the requirement for restriction. While the claims do not specifically identify the various subgroups, they are nonetheless disclosed as falling within the scope of the linking claim in the specification. Thus, the claims still read on the various inventions amongst which restriction is required. Because the Applicant did not make the required elections, the Applicant's Response to the Requirement for Restriction is considered Non-Responsive.

2. The reply filed on November 19, 2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant did not make the elections required in the Requirement for Restriction. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

3. Those portions of the Restriction Requirement setting forth the elections to be made have been reproduced below.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Art Unit: 1648

- I. Claims 1-16, drawn to methods for determining if a compound affects a life phase of a virus, classified in class 435, subclass 5.
- II. Claims 17, 21, and 22, drawn to methods for determining if two compounds affect the life phases, each in different virus, classified in class 435, subclass 5.
- III. Claims 18-20, drawn to methods for determining the absence of a compound on a phase of a viral life cycle, classified in class 435, subclass 5.

If the Applicant elects Group I above, the Applicant is further required to elect under 35 U.S.C. 121 one of each of the following subinventions:

- i) one of the viruses identified in claim 13,
- ii) either the adenovirus early protein from early region 1 or early region 2, and
- iii) one of the following methods of determining the effect of a compound on the viral life cycle:
 - (a) examining a cellular protein's activity;
 - (b) examining a cellular protein's amount;
 - (c) examining the interaction of the virus with the cell;
 - (d) examining the virus' activity;
 - (e) examining the amount of the virus;
 - (f) examining the activity of a viral fragment;
 - (g) examining the amount of a viral fragment; or
 - (h) examining the cell's viability.

If the Applicant elects Group II above, the Applicant is further required to elect under 35 U.S.C. 121 one of each of the following subinventions:

- i) two of the viruses identified in claim 13,
- ii) either the adenovirus early protein from early region 1 or early region 2, and
- iii) one of the methods identified in iii) above.

If the Applicant elects Group III above, the Applicant is further required to elect under 35 U.S.C. 121 one of each of the following subinventions:

- i) one of the viruses identified in claim 13,
- iii) one of the following methods of determining the effect of a compound on the viral life cycle:
 - (a) examining a cellular protein's activity;
 - (b) examining a cellular protein's amount;
 - (c) examining the interaction of the virus with the cell;
 - (d) examining the virus' activity;

Art Unit: 1648

- (e) examining the amount of the virus;
- (f) examining the activity of a viral fragment;
- (g) examining the amount of a viral fragment; or
- (h) examining the cell's viability.

If the Applicant elects Group III, the Applicant is additionally required to elect one of subinventions (A) or (B). Each of these subinventions represents the elected group wherein the absent compound is (A) a natural constituent of the cell, or B) a natural constituent of the virus.

Election of Species

5. Claim 3 is generic to a plurality of disclosed patentably distinct species comprising individual species of virus from each of the identified families of virus, examples of which are identified in paragraph [0040] of page 10 of the application. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even if this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

6. It is here noted that some of the restrictions requirements made above fall within the scope of PTO Linking claim practice. In accordance with this practice as described in MPEP 809.03, linking claims will be considered with the elected invention. If the elected invention is

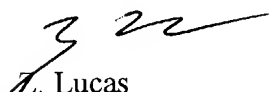
Art Unit: 1648

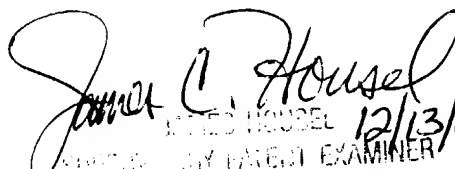
found allowable, the linking claim will also be examined. If no substantive rejection is found for the linking claim, the restriction among the Groups it comprises will be withdrawn.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Z. Lucas
Patent Examiner


JAMES A. HOUSEL
12/13/04
PATENT EXAMINER
RECEIVED BY CENTER 1600